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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,071	11/12/2007	Ron Golan	524283-0319040 (B&B-137)	9098
36183 7590 10/15/2010 PAUL, HASTINGS, JANOFFSKY & WALKER LLP 875 15th Street, NW Washington, DC 20005				
EXAMINER YAN, REN LUO				
ART UNIT 2854		PAPER NUMBER		
MAIL DATE 10/15/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/555,071

Applicant(s)

GOLAN, RON

Examiner

Ren L. Yan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
Paper No(s)/Mail Date 5-2-2008, 6-30-2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of invention Group II, claims 25-39 in the reply filed on 8-5-2010 is acknowledged. The traversal is on the ground(s) that the subject matter of all of claims 1-39 is sufficiently related that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of the non-elected claims. This is not found persuasive because the product as claimed in the elected invention can be produced by various methods and the patentability of a product does not depend upon the particular method used to produce the product. It is the structure of the product itself that is judged against the known prior art regardless under which method the product is made. Accordingly, the search strategy and search queries used in searching for the elected product claims would be very different from the search strategy and search queries used in searching for the non-elected method claims.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-27 and 30-39 are rejected under 35 U.S.C. 102(b) as being anticipated by McGrew (5,396,559).

With respect to claim 25, McGrew teaches the structure of a substrate comprising an embossed hidden image 1200, the hidden image is embossed onto a substrate, the hidden image is created in association with an optical frequency not visible to the naked eye, the hidden image cannot be seen without the use of a decoder having a reverse optical frequency. See Figs. 4A-4C, 12, 13, the abstract and column 4, line 63 to column 5, line 12, column 5, lines 40-58, and column 7, line 45 through column 8, line 62 in McGrew for details.

Regarding claim 26, McGrew teaches wherein the substrate is a material having sufficient flexibility (an identification card) to be used in the process of embossing.

Regarding claim 27, McGrew teaches wherein the substrate is made of a polymeric sheet (The identification card is usually made of plastic material) or metal sheet or processed wood or processed leather or a composite material.

Regarding claim 30, McGrew teaches wherein the hidden image comprises text or at least one animated figure or a combination thereof.

Regarding claim 31, McGrew teaches wherein the substrate is any one of the following substrates: polymer, fabric, wood, metal, or a composition thereof.

Regarding claim 32, McGrew teaches wherein the hidden image is used for determining whether the substrate is original or approved.

Regarding claim 33, McGrew teaches wherein the hidden image is used for revealing a message or an image.

Regarding claim 34, McGrew teaches wherein the hidden image is used for determining the substrate's authenticity.

Regarding claim 35, McGrew teaches further comprising a decoder(a reference mask)

attached thereto for revealing the hidden image.

Regarding claim 36, McGrew teaches the structure of a substrate comprising a decoder (Figs. 7A and 7B where a reference mask is superimposed on the message mask) for viewing an embossed hidden image (Fig. 7B), the decoder comprises embossed or printed lines having a reverse optical frequency to the optical frequency used to create the hidden image embossed onto a substrate. See also column 6, lines 19-29.

Regarding claim 37, McGrew teaches wherein the decoder (the reference mask) is made of a polymer material.

Regarding claim 38, McGrew teaches wherein the decoder is made of a clear material allowing the placement of the decoder upon the substrate containing the hidden image so that when the decoder is placed in a predetermined angle the hidden image is revealed through the decoder (Figs. 7A, 7B and column 6, lines 19-29).

Regarding claim 39, McGrew teaches a substrate (Figs. 7A and 7B) comprising an embossed hidden image. See also the abstract of McGrew.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrew in view of JP 2-18050.

With respect to claims 28 and 29, McGrew teaches that of the dot pattern in the reference mask and the massage mask can be printed or embossed.

However, McGrew does not discuss the dimensions of the embossed recesses.

JP 2-18050 teaches embossing a decorative resin board with embossing platens to produce embossed patterns comprises recesses in a depth of about 1-60 Microns and a diameter of about 1-30 Microns at the upper surface of the board. See the English abstract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the substrate of McGrew with the embossed hidden image comprised recesses in a depth of about 1-60 Microns and a diameter of about 1-30 Microns at the upper surface of substrate as taught by JP 2-18050 so as to predictably achieve the hidden image having a high aesthetic appearance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ren L Yan/
Primary Examiner, Art Unit 2854
Oct. 12, 2010